

it is made (see MPEP § 2173.05(p)). Therefore, the Applicant respectfully submits that claims 5-7 and 13-15 are not product-by-process claims.

The Official Action rejects claims 1-3, 10 and 11 as obvious based on the combination of U.S. Patent No. 5,789,733 to Jachimowicz and U.S. Publication No. 2003/0052324 to Kimura. The Official Action rejects claims 5-7 and 13-15 as obvious based on the combination Jachimowicz, Kimura and U.S. Patent No. 4,575,621 to Dreifus. The Official Action rejects claims 4 and 12 as obvious based on the combination of Jachimowicz, Kimura and U.S. Patent No. 6,590,633 to Nishi. The Official Action rejects claims 8 as obvious based on the combination of Jachimowicz, Kimura, Nishi and Dreifus. The Official Action rejects claims 9 and 16 as obvious based on the combination of Jachimowicz, Kimura, Dreifus and U.S. Publication No. 2004/0152392 to Nakamura. The Applicant respectfully traverses the rejection because the Official Action has not made a *prima facie* case of obviousness.

As stated in MPEP §§ 2142-2144.04, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some reason to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art, either alone or in combination, does not teach or suggest all the features of the independent claims. Independent claims 1-8, 10, 12 and 13 recite a semiconductor device comprising an antenna, among other features. For the reasons provided below, Jachimowicz, Kimura, Dreifus, Nishi and Nakamura, either alone or in combination, do not teach or suggest the above-referenced features of the present invention.


The Official Action asserts that "Jachimowicz et al discloses ... an antenna (14) (Fig. 2, col. 3, lines 29-30)" (page 3, Paper No. 20090513). The Applicant respectfully disagrees and traverses the assertions in the Official Action. Jachimowicz discloses a microchip 14. The microchip 14 of Jachimowicz is not an antenna. The Applicant respectfully submits that Kimura, Dreifus, Nishi and Nakamura do not cure the deficiencies in Jachimowicz. Therefore, the Applicant respectfully submits that Jachimowicz, Kimura, Dreifus, Nishi and Nakamura, either alone or in combination, do not teach or suggest a semiconductor device comprising an antenna.

Since Jachimowicz, Kimura, Dreifus, Nishi and Nakamura do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

The Commissioner is hereby authorized to charge fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(a), 1.20(b), 1.20(c), and 1.20(d) (except the Issue Fee) which may be required now or hereafter, or credit any overpayment to Deposit Account No. 50-2280.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert L. Pflaud", is written over a horizontal line.

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